



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : Confirmation No. 9671

Makoto NISHIMURA et al. : Attorney Docket No. 2003\_0976A

Serial No. 10/620,611 : Group Art Unit 3663

Filed July 17, 2003 : Examiner Charlie Hung Le

METHOD AND APPARATUS FOR  
WORKING TUBE

THE COMMISSIONER IS AUTHORIZED  
TO CHARGE ANY DEFICIENCY IN THE  
FEES FOR THIS PAPER TO DEPOSIT  
ACCOUNT NO. 23-0975

**RESPONSE**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In response to the Restriction Requirement of May 24, 2006, Applicants hereby elect with traverse Group I, which is drawn to a method for working a tube and is embodied by claims 1-10.

The Examiner is requested to withdraw the requirement for restriction because there would be no serious burden on the Examiner if restriction were not required.

The first Office Action considered claims 1-12, which were drawn to a method (1-10) and an apparatus (11-12). In other words, the Examiner has already considered the method and the apparatus.

Applicants assume that the first action was "complete" because that is what is required by **37 CFR 1.104(b)** ("the Examiner's action will be complete as to all matters"). See also **MPEP 904.03** and **37 CFR 1.104(a)(1)** which requires that the Examiner, on taking up an application for examination, make a thorough investigation of the available prior art relating to the subject matter of the claimed invention.

Since the Examiner has already considered and searched both the method and the apparatus, there will be no serious burden to support the restriction requirement.

**MPEP 808** instructs that every requirement to restrict has two aspects:

(1) the reasons why each invention as claimed is either independent or distinct from the other;

and

(2) the reasons why there would be a serious burden on the examiner if restriction is not required.

Further, **MPEP 811** instructs that the Examiner, before making a restriction requirement after a first action on the merits, must consider whether there will be a serious burden if restriction is not required. In this case, the Examiner has already searched both the method and the apparatus. Thus, requiring restriction at this point in the prosecution would not relieve the Examiner of any serious burden.

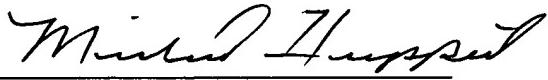
Further, the response to the first Office Action consisted merely of making minor editorial amendments and accepting the allowable subject matter that was indicated in the first Office Action. Clearly, the filed response would not have necessitated any further search.

In view of the above, the Examiner is respectfully requested to withdraw the requirement for restriction. In the event that the Examiner decides to maintain the restriction requirement, then the Examiner is requested to explain how there could be a serious burden if restriction was not required.

Respectfully submitted,

Makoto NISHIMURA et al.

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